

## RESPONSE TO THE REJECTIONS - ARGUMENTS

- 1) Claims 1-30 have been **finally** rejected under 35 USC 103(a) as unpatentable over US Patent No. 5,863,041 (Boylan) in view of US Patent No. 4,948,134 (Suttle).

### **Response to Examiner's Comments**

The Examiner has provided helpful comments on pages 6 and 7 of the Final Office Action that explain the position of the PTO based on responses to arguments provided by Applicants. It is believed that these comments can be fairly summarized as follows:

- a) Boylan is asserted to teach every element of the claimed subject matter except for:
  - i. i) providing an additional award to players who have placed an additional wager (e.g., Play wager after placing the Ante wager); and
  - ii. Requiring the Dealer hand to be equal to or less than a predetermined rank.
- b) Suttle is asserted to teach i) and ii); and
- c) It is asserted to be obvious to combine the Suttle steps of i) and ii) into the Boylan game to provide a player with more winning chances.

The problem with this analysis is that Suttle does not teach "...and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank." Suttle teaches providing a payout on a Play wager **ONLY when the Dealer hand equals or EXCEEDS a minimum rank**. The play in Suttle awards additional amounts only when the Player's hand is better than a particular ranked hand of the dealer, usually A-K or better. This in effect lets the Dealer fold against the Play wager if the dealer hand has no chance of winning.

An opposite effect and opposite rule of play is recited in the present application. Here, the Dealer can never fold and the player's additional wager (the Play wager) is in play only when the Dealer has a weak hand (equal to or **less than** a predefined rank).

This has significant strategic benefits to players and overcomes some adverse result situations, where the player has a high quality hand, makes the Play wager in expectation of winning multiples on the Play wager, and then wins only on the Ante because the Dealer has a weak hand, even though the Player's hand far exceeds the rank of the weak Dealer hand. This has been noted by Applicant as a significant adverse situation in the play of the Suttle game of Caribbean Stud® poker.

The present method offers an optional wager (a Play wager against a payable requiring a Dealer to have a relatively low ranking hand) that can allow the player to win, even when the Dealer would have folded in normal play of the Dealer's cards, according to the Rules of Suttle, requiring **at least an A-K or higher to qualify**.

**IT IS ABSOLUTELY CLEAR THAT THE STEP OF HAVING ANY WAGER THAT INCLUDES A PAYOUT SPECIFICALLY WHEN THE DEALER FAILS TO MEET A MINIMUM HAND RANK (e.g., a predetermined hand rank or less, as recited in the claims) IS NOVEL AND UNOBVIOUS.** That recited step is completely absent from the teachings of Boylan and/or Suttle. It provides a different expectation and result from the play of the actual games of Boylan and/or Suttle.

The rejection and the Examiner's comments arguing in support of the rejection are clearly in error. It should be noted that Applicant's are so comfortable and certain of the patentability of their originally claimed subject matter over the rejection of record that no amendments have been filed during the prosecution to avoid this art.

It is further to be noted that even though the rejection asserts that Boylan teaches every limitation of claim 1 except for the following steps, that rejection is in error. The rejection says Boylan is absent the teachings of only:

(g) providing an extra award to players who have placed the optional wager:

(i) when the player's best five-card poker hand equals or exceeds a predetermined rank and

(ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

It is asserted that Suttle teaches a method of playing poker (although not Pai Gow poker) which provides an additional award to players who have placed the optional wager (e.g.,

placing bet after an "ante") when that player's best five-card poker hand equals or exceeds a predetermined minimum rank (Col. 2, lines 32-35; and Col. 4, lines 22-52) and when a best five-card poker hand for the dealer is equal to or less than a predetermined rank (e.g., when the dealer's hand is less than Ac-King; Col. 2, lines 32-35; and Col. 4, lines 2-12).

It is asserted to be obvious to provide the poker rule of Suttle to Boylan's Pai Gow poker game to provide more winning chances.

Applicant traverses this rejection at least for the reasons that:

- d) Suttle does not teach the limitations for which it is cited; and
- e) Even if Suttle taught the limitations for which it is cited, the limitations of Suttle could not be merely added to the play of the Boylan game.

It is first to be noted that, after conclusion of the underlying Pai Gow poker game, Boylan actually plays three separate games based on the side bet, even with a requirement of a greater than minimum side bet, as recited in Boylan as:

**Game 1** - arranging, by the dealer for each player, of a best poker hand consisting of any selected five of the seven cards dealt to each player and formerly comprising the two-card hand and the five-card hand; determining, by the dealer, whether the best poker hand of each player has a poker rank equal to or better than a first predetermined poker rank but less than a second predetermined poker rank; paying off of the bonus bet by that player if that player has a best poker hand ranked equal to or better than the first predetermined poker rank but less than the second predetermined poker rank;

**Game 2** - determining, by the dealer, whether the best poker hand of each player has a poker rank better than or equal to the second predetermined poker rank; playing of an auxiliary game of chance by each player having a best poker hand better than or equal to the second predetermined poker rank to determine whether each player is a winner or loser of the auxiliary game; paying off of the bonus bet to each player having a best poker hand ranked better than or equal to the second predetermined poker rank at a first payoff where the player is a loser in the auxiliary game and at a second payoff higher than the first payoff where the player is a winner of the auxiliary game; and

**Game 3** - determining whether each player has made an bonus bet of a predetermined minimum which thus qualifies as an envy bet; and paying off of any envy bet by each player if any other player has a best poker hand equal to or better than a third predetermined poker rank.

Game 1 is a limited range bonus bet, with an unusual cap on the amount paid off because of the exclusion of highest ranked hands. This game is within the scope of the present claims of Applicant.

Game 2 is a limited bad beat event, paid off only when the player loses the auxiliary game, which might even be an event totally outside the play of the Pai Gow card game (e.g., rolling three dice). This game is not specifically included in the game play claimed by Applicant (although allowed under the claim language of "comprising"). However, this game play method is not equivalent to the last step of Applicant's method of:

- g. providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

Additionally, this highlighted step recognized as absent from the teachings of Boylan by the Patent and Trademark Office, is not taught by Suttle.

Game 3 is an envy bet wherein if **another player** has a third predetermined high ranked hand, players making a higher than minimum bonus wager win Game 3. This game is within the scope of claims of Applicant, noting specifically claim 6:

The step recited in Claim 1:

- g. providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

and the interdependent steps of claim 12:

- f. paying players who have both placed the additional wager and provided hands of at least the predetermined rank according to the pay table and rules of the separate poker-type game played with best five-card hands of the players; and
- g. if a best 5-Card hand for the dealer from the dealer's Pai Gow cards is equal to or less than a predetermined rank, increasing the amount of payment to players from f).

are not taught by Suttle. As these steps, admitted to be absent from Boylan, are not taught by Suttle, and as the very nature of those steps is fundamentally different from either the underlying game of Boylan or the underlying game of Suttle, there is no basis for implying obviousness of these steps and play that are recited in the claims and not specifically shown in the references.

It is easiest to review the limitation of claim 12 first to appreciate the differences in these unique steps. Claim 12, step f), basically requires paying players for Game 1 of Boylan. **However, this step is substantively modified by step g) in a way not appreciated by the rejection.** Step g) states that even if the player wins in step f) (and in fact the player **has to win in step f) by having the predetermined high ranked hand**), the player can win **MORE** than he ordinarily would have if the dealer's best 5-card poker hand equals or is **LESS THAN** a predetermined rank. That is, the player is paid **MORE** when the dealer has a lower range of 5-card poker ranks (e.g., a Pai Gow rank in the 5-Card hand). This is substantively different than the play events in either Boylan or Suttle.

It is first noted that the PTO admits the failure of Boylan to teach that step. However, the steps taught by Suttle will be compared with the steps of the present claims to show the substantive difference between those additional steps of Applicants and the teachings of Suttle.

CLAIM 12 OF APPLICANT	SUTTLE PROCESS	COMMENTS
b. Players placing an	Suttle has a mandatory Play	<b>Both games allow for a</b>

optional wager on a separate poker-type game that uses best five-card hands from player cards;	wager (after viewing cards) for the player to remain in the game. There is an optional Progressive jackpot wager on a 5-card poker game.	<b>side bet, even though the games involved are different.</b>
f. paying players who have both placed the additional wager and provided hands of at least the predetermined rank according to the pay table and rules of the separate poker-type game played with best five-card hands of the players; and	<b>Suttle pays players for predetermined ranks of hands according to a pay table used with the optional side bet.</b>	
g. if a best 5-Card hand for the dealer from the dealer's Pai Gow cards is equal to or less than a predetermined rank, increasing the amount of payment to players from f).	<b>Suttle pays the player on the side bet, irrespective of the rank of the dealer's hand. Suttle pays the player on the Ante, irrespective of the rank of the dealer's hand.</b>	<b>Suttle pays the player on the play wager ONLY if the dealer's hand has a minimum rank or HIGHER. Effectively the dealer "folds" with a low hand.</b>

The impact of the recited rules in claim 12 is that, even where a player has a winning hand in the 5-card poker auxiliary game, the required award resulting from the optional **SIDE BET** is **INCREASED** when the dealer has a low ranked hand.

Boylan teaches that the player must lose the auxiliary game to be able to win Game 2. That is directly opposite in concept to what is recited in steps f) and g) of Claim 12. In steps f) and g), the player must win step f) to win step g).

Suttle teaches that a win on a mandatory wager (the Play wager, which must be placed by the player if that player wants to remain in the game) occurs only when the dealer hand is **at least a minimum rank (or higher) AND the player beats the actual hand of the dealer**. The effect of a lower than the minimum rank on the dealer's hand is to eliminate or lower one potential award to the player, while the present step g) of claim 12 enables players to **INCREASE AN EXISTING WIN** without further risk when the dealer has a low hand. Again, the effect of a low hand in Suttle is reduced payment to a player and the effect of a low hand in Claim 12 of Applicant is an increased win. The rules of Suttle and Claim 12 of Applicant tend to be directly opposite in play and impact.

Additionally, the rank of the dealer's hand in Suttle has no impact on the side bet wager. While the rank of the dealer's hand does have a positive impact on potential winnings for a player in Claim 12 of Applicant's game.

The rejection attempts to assert the effect of combining the mandatory PLAY wager of Suttle with the effect of the side bet wager of Claim 12 of Applicant, and this attempt is erroneous and confuses the issues rather than establishing obviousness. The PLAY wager of Suttle is not an optional side bet. It is a mandatory wager to stay in the game against the dealer hand. If a player does not make that PLAY wager, the Ante wager is forfeited. That is not a side bet wager, but is a PLAY or "base game" wager, similar to a CALL bet in standard poker. The player must call the dealer or the player's hand is folded.

The PLAY wager of Suttle is further distinguished from the language of Claim 12 that requires "**optional wager on a separate poker-type game** that uses best five-card hands from player cards." The PLAY wager is on the same game as the Ante wager, a game against the dealer hand and not a separate poker-type game.

It is absolutely clear that the more the games steps of play of Suttle are compared to the limitations f) and g) of Claim 12, the greater the difference between the steps, and the greater the difficulty (if not impossibility) in asserting obviousness of Claim 12 with respect to Boylan in view of Suttle. The rejection of claims 12-20 has been strongly shown to be in error.

Claim 1 is also non-obvious in view of the combination of Boylan in view of Suttle, for many of the same reasons. Although Claim 1 allows for the **side bet** to be mandatory or optional (while it was only optional in Claim 12), the substance of step g) of Claim 1 is substantially similar to the recitation of both steps f) and g) in Claim 12. Note that the language:

- g. providing an additional award to players who have placed the optional wager i) when that player's best five-card poker hand equals or exceeds a predetermined rank and ii) when a best five-card hand for the dealer is equal to or less than a predetermined rank.

This step requires **BOTH** the player to win an additional award in a predetermined rank side bet event (step f) in Claim 12) **AND** then for the dealer to have a low ranked hand to provide the player with **an additional award**.

Claims 1-11 are therefore clearly patentable for all the reasons presented above with respect to steps f) and g) (excluding at least the purely optional nature of the side bet).

If the Patent and Trademark Office mistakenly wishes to repeat this fatally defective rejection, explanations of at least the following issues are respectfully requested to be clarified:

- a) No reference shows increasing an existing award when a dealer's hand has a low rank (a predetermined rank or **lower**).
- b) No reference shows an increased award on a side bet when the dealer's hand has a low rank (a predetermined rank or **lower**).

The rejection of claims 1-20 is clearly in error and no amendment to the claims was necessary in providing arguments over the rejections.

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**CONCLUSION**

It is believed that all claims are in condition for allowance. The rejections must be withdrawn and a notice of Allowance provided.

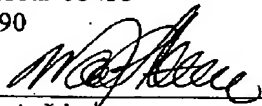
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